Remark

Applicant respectfully requests reconsideration of this application as amended. Claims 1 and 31 have been amended. No claims have been cancelled. Therefore, claims 1,3-24, and 29-33 are present for examination.

35 U.S.C. §103 Rejection

The Examiner has rejected claims 1, 3-24, and 29-33 under 35 U.S.C. §103(a) as being unpatentable over Gates, U.S. Patent No. 5,701,409 (hereinafter "Gates"), in view of official notice.

Official Notice

The Examiner took official notice that "the storing of commands in an instruction memory for the purpose of speeding up the time needed to process instructions" was well known. The undersigned is unclear whether the Examiner is implying that any memory that holds a plurality of instructions is equivalent to the instruction memory of claim 1 and the other claims of the application. The undersigned submits that an instruction memory that is configured to store a plurality of predefined bus stimuli instructions, wherein the stimuli represent a plurality of bus transactions, is not common knowledge or well known in the art. Accordingly, as per MPEP 2144.03, the undersigned challenges the Examiner's assertion and asks him to present a reference in support of his assertion.

Claim 1 (as amended) and dependent claims 3-14 and 31-32

In order to present a valid prima facie case of obviousness, the Examiner must meet three criteria: 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the reference or combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference must teach or suggest all of the claim limitations. The Examiner fails to satisfy any of these required criteria.

The First Obviousness Criteria

The Examiner has failed to present evidence to satisfy the first criteria. There is no motivation to combine an "Instruction memory" capable of storing "a plurality of predefined bus stimuli instructions" with the teachings of Gates. In fact, modifying Gates by adding a memory containing the capacity to store multiple commands would be nonsensical, since Gates clearly and distinctly teaches to clear the command register once a single command is driven on the bus. *See Column 2, lines 59-62 of Gates.* The Examiner is kindly requested to read the preliminary amendment filed by the undersigned on 8/22/2000, wherein on page 9-10 the issue of replacing Gates single command registry with a memory capable of storing multiple commands is discussed, indicating how Gates actually teaches away from such a combination.

The Third Obviousness Criteria

The Examiner has failed to satisfy the third obviousness criteria. Despite the Examiner's assertions otherwise, Gates does not teach the claim 1 limitation, "the one or more phase generators to drive a series of signals on the bus corresponding to the predefined bus stimuli instructions in a predefined sequence." As discussed in detail in previous office action responses, Gates is only capable of driving a SINGLE error command onto the bus representing at most a single bus transaction and therefore fails to teach or suggest "one or more phase generators" that can drive a SERIES of signals in a predefined sequence that correspond to the predefined bus stimuli.

The undersigned respectfully requests that the Examiner review the arguments presented in the previous office actions, which detail the distinctions between Gates and claim 1 in great detail. *See Final Office Action Response mailed 6/06/00; see also Preliminary Amendment mailed on 8/22/00.*

The Second Obviousness Criteria

The Examiner has failed to satisfy the second obviousness criteria. As indicated above in the previous two sections, Gates does not teach a phase generator capable of driving any more than a single signal onto a bus. By merely adding a memory capable of holding more than one bus stimuli instruction to the error generation circuit of Gates, it is not reasonable or even likely that the Gates' error generation device would perform in the manner required by the limitations of claim 1. To the contrary, Gates teaches to clear the registry after driving a signal onto the bus. Any additional instructions stored in memory would be cleared as well. Accordingly, there is little likelihood of success in modifying Gates the way the Examiner suggests.

The undersigned submits that the necessary motivation and teachings required to modify Gates' error generation circuit to perform like the device of claim 1 exist in the applicant's application. But as the Examiner is aware, using hindsight gained from applicant's specification is impermissible in presenting a valid prima facie case of obviousness. Accordingly, the undersigned submits that the Examiner has failed to present a valid prima facie case of obviousness against claim 1 and its dependent claims, and that claim 1 is, therefore, in a condition of allowance over Gates.

Claims 15, 16, 21, 29 and Associated Dependent Claims

For at least the reasons cited above with regard to claim 1, claims 15,16, 21, 29 and associated dependent claims are in a condition of allowance over Gates.

Conclusion

Applicant respectfully submits that the rejections have been overcome by the amendment and remark, and that the claims as amended are now in condition for allowance. Accordingly, Applicant respectfully requests the rejections be withdrawn and the claims as amended be allowed.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Request for an Extension of Time

The Applicant respectfully petitions for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. . Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. §1.17 for such an extension.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 01|02|01

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